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For: The Gates Corporation,
Signature: Sonja Fuller
Date signed: July 30, 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Donald R. Gilbreath	Examiner: Dunwoody, Aaron M.
Serial No.: 10/723,126	Group Art Unit: 3679
Docket No.: C02-085A	
For: HYDRAULIC HOSE FITTING AND METHOD	July 30, 2009

Via Fax: (571)273-8300
The Honorable Commissioner for Patents
MS PETITION
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR § 1.144

Applicant respectfully petitions the Director under 37 CFR § 1.144 for review of the requirement for restriction in the above-identified patent application. The requirement for restriction was first presented in the final Office Action mailed on April 4, 2006 and reiterated in the separate restriction requirement mailed on March 9, 2007. Applicant replied to the initial restriction in a response filed on October 4, 2006 and the separate restriction requirement was addressed in an election filed March 19, 2007. The Restriction was made final in the Office Action mailed June 7, 2007, and this finality has been reiterated in subsequent Office Actions in response to Applicant's further requests for reconsideration). This petition is filed concurrent with a Notice of Appeal, and is thus timely presented under 37 CFR § 1.144.

The restriction(s) required election between:

I. Claims 1-5, drawn to a fitting, classified in class 285, subclass 356; and

II. Claim 6, drawn to a method for producing a hydraulic fitting, classified in class 29, subclass 890.014.

The restriction(s) asserted that inventions are distinct, each from the other because the inventions of Group II and Group I are related as apparatus and product made and the product as claimed can be made by another and materially different process such as a heated press-fit. The restriction(s) went on to assert that because these inventions are independent or distinct and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes was proper.

In the reply of October 4, 2006, the election of March 19, 2007 and/or subsequent other office action response, Applicant has presented the following arguments:

Examination of all of the claims did not, and does not, present a serious burden.

Applicant respectfully points out that M.P.E.P. § 803 requires: "If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." In the present case, the Examiner has already examined all of claims 1-6 and opined as to their patentability in the Office Action of July 6, 2004. The amendments made to claim 6 in Applicant's September 16, 2005 Amendment included only limitations speaking to a collar, similar to limitations already present in the other independent claims. Therefore, Applicant respectfully asserts that there was, and is, no serious burden on the Examiner to search and examine all of the claims, as he has already searched and examined the claims and their various limitations.

Restriction is advanced under the improper theory.

The restriction alleges the inventions are distinct, each from the other because the inventions of Group II and Group I are related as apparatus and product made under MPEP § 806.05(g). However, Applicant notes that MPEP § 806.05(g) is directed to restriction between an apparatus and a product made by the apparatus. As noted in the restriction requirement itself claims 1-5 are drawn to a fitting and claim 6 is drawn to a method for producing a hydraulic fitting. While the fittings of claims 1-5 may be viewed as an apparatus or a product,

the method of claim 6 cannot be viewed as an apparatus or product. It appears from the language of the restriction, including the statement "the product as claimed can be made by another and materially different process such as a heated press-fit," that the Examiner is viewing the method of claim 6 as an apparatus. This is erroneous and for this reason alone, the restriction requirement should be overruled.

Restriction logic is flawed.

Regardless, the Examiner's logic for making the restriction requirement is flawed. The Examiner indicates that the inventions are distinct because: "the product as claimed can be made by another and materially different process such as a heated press-fit." However, as previously pointed out in this case, each of independent claims, claims 1, 2 and 4, recite an element such as "said collar support portion including knurling and an axial stop ring." Applicant respectfully asserts that inclusion of knurling and an axial stop ring in a collar support portion of a fitting insert cannot be accomplished by heated press fitting or the like. Further, each of independent claims 1, 2 and 4 (of alleged Invention Group I) recite elements speaking to the torque communication portion being staked to provide communication with the knurling in a relatively non-rotational manner. Similarly, independent claim 6 (of alleged Invention Group II) recites "staking said collar at said torque communication portion to affix said collar upon said stem in a relatively non-rotational manner." Thus, Applicant fails to understand how one might employ a materially different process, such as a heated press-fitting, to make the product of claims 1-5 by another and materially different process.

Conclusion

Each of the defects discussed above is a sufficient reason for the restriction requirement to be withdrawn. The combination of these defects makes it clear that the restriction requirement was improper and should be withdrawn.

Since 37 CFR §1.144 does not indicate that a fee is required for a petition thereunder, the present Petition is not accompanied by any such fee. (However, Applicant notes that a petition for a one-month extension of time does accompany the concurrently filed Notice of Appeal.) Still, if any additional fee is due, please charge Deposit Account No. 07-0475, from which the undersigned is authorized to draw.

Applicant respectfully requests that the Office call the below listed attorney if the attorney can be helpful in resolving any remaining issues or can otherwise be helpful in expediting review of this Petition.

Respectfully submitted,

Dated: July 30, 2009

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